

REMARKS

Applicant has carefully reviewed the Official Action dated May 19, 2005 placing the above identified patent application under final rejection.

Applicant requests that the finality of the rejection in the Official Action dated May 19, 2005 be withdrawn for the following reasons.

Claim 12, which was rejected as being anticipated by Okie et al in the Official Action dated October 28, 2004 was not revised in the Amendment filed on November 22, 2004, in response to the October 28, 2004 Official Action. However, in the Final Action dated May 19, 2005, Claim 12 was rejected over Edmunds, a newly applied prior art reference. As a result, it is improper to place this application under final rejection in the Official Action dated May 19, 2005 in view of MPEP Section 706.07(a) which states, in pertinent part:

"...Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art...".

Since Claim 12 was not amended prior to the Final Action, and was rejected over newly applied prior art in the Final

Action, it is improper to place the application under final rejection at this time. Applicant therefore respectfully requests that the finality of the Official Action dated May 19, 2005 be withdrawn.

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An Information Disclosure Statement together with Form PTO-1449 and copies of ten (10) references identified on Form PTO-1449 were filed on September 12, 2003, together with the original application papers. Of the ten (10) references cited in the Information Disclosure Statement, only U.S. Pat. No. 4,519,478 (Hulme) has been formally cited of record in connection with the patent application. Applicant respectfully requests that the additional nine (9) references cited in the previously filed Information Disclosure Statement be formally cited of record in connection with the present application as further illustrating the background state of the art.

* * *

Referring now to the Official Action dated May 19, 2005, Claims 5, 11 - 12 and 14 - 20 have been rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for the reasons discussed at page 2 of the Official Action. With regard to the formal grounds of rejection of Claims 11 - 12 and 14 - 20, Applicant respectfully incorporates by reference the arguments

advanced starting at page 8, last paragraph and continuing through page 9, first paragraph of the Amendment filed on November 22, 2004. These claims, in their present form, will clearly be understood by persons skilled in the art to define the nature of the claimed invention in a manner fully compliant with 35 U.S.C. Section 112, second paragraph.

With regard to the formal ground of rejection of Claim 5, the form of Claim 5 has been amended to replace the recitation of "a conventional ladder" with "said ladder" to be consistent with the terminology employed in parent independent Claim 21, similar to the amendments made to the form of Claims 6 - 7 in the Amendment filed on November 22, 2004. The present amendment to the form of Claim 5 should have been made in the Amendment filed on November 22, 2004, but was inadvertently overlooked by Applicant at that time. Applicant submits that the amendment to the form of Claim 5 made herein overcomes the formal ground of rejection raised against Claim 5 in the latest Official Action.

* * *

Independent Claims 11, 18, and 21 are pending in this application. In the Official Action dated May 19, 2005, independent Claims 11 and 18 have been rejected as being anticipated by the previously applied Brugner patent; independent Claims 11, 18 and 21 have been rejected as being anticipated by the previously applied British publication (Lee); independent

Claim 21 has been rejected as being anticipated by the newly applied Hulme et al patent; independent Claim 21 has been rejected as being anticipated by the newly applied Edmunds patent; and independent Claim 21 has been rejected as being obvious over a combination of the newly applied Jenkins patent in view of the previously applied Lee publication. Applicant respectfully disagrees with these prior art rejections, and respectfully requests that they be reconsidered and withdrawn for the reasons discussed as follows.

With regard to the rejection of independent Claims 11 and 18 as being anticipated by Brugner, Applicant incorporates by reference the arguments advanced starting at page 10, last paragraph, through page 11, last full paragraph of the Amendment filed on November 22, 2004.

With regard to the rejection of independent Claims 11, 18 and 21 as being anticipated by the Lee publication, Applicant incorporates by reference the arguments advanced at page 10, second full paragraph of the Amendment filed on November 22, 2004 - namely, that the Lee publication discloses only an attachment to a ladder for stabilizing the ladder for preventing lateral sway of the ladder, and does not teach or suggest an extension for a ladder.

With regard to the rejection of independent Claim 21 as being anticipated by the newly applied Hulme et al patent,

independent Claim 21 expressly recites that the distance between the opposed sidewalls of the ladder extension is greater than the distance between the opposed sidewalls of the ladder to which the extension is mounted. On the contrary, the Hulme et al patent discloses an extension section 10 received within the sidewalls of a ladder 20, exactly opposite in arrangement to that recited in independent Claim 21.

With regard to the rejection of independent Claim 21 as being anticipated by the newly applied Edmunds patent, Applicant notes that Edmunds discloses a device for splicing two conventional ladders together, and does not disclose a conventional ladder in combination with a ladder extension. Therefore, the disclosure of Edmunds, which advocates the use of two full size conventional ladders spliced together, defeats the intended objective of the invention defined by independent Claim 21, which is to eliminate the need to carry two full-size ladders, but instead enables a workman to carry a single conventional ladder together with a shorter ladder extension.

A rejection of claims as being anticipated by the prior art requires the Patent & Trademark Office to establish a strict identity of invention between a single prior art reference and the rejected claim. Applicant respectfully submits that there is clearly no strict identity of invention between any of the references applied to reject independent Claims 1, 18 and 21, respectively, and the rejected claims, and therefore the applied

references do not anticipate (or suggest) the invention defined by the independent claims pending herein.

With regard to the rejection of independent Claim 21 as being obvious over a combination of the previously applied Lee publication and the newly applied Jenkins patent, Applicant refers to the arguments advanced with respect to the Lee publication, namely that this reference does not teach or suggest a ladder extension as disclosed by Applicant and specifically recited in independent Claim 21. Additionally, the Jenkins patent does not disclose a ladder extension, but is directed to a specialized ladder for hanging paper. The top section of the ladder does not engage lower rungs of the ladder section, but on the contrary, it is necessary to drill aligned openings in the top and bottom ladder sections to retain these two sections together. Therefore, neither the Lee publication or the Jenkins patent teaches or suggests the ladder and ladder extension combination defined by independent Claim 21. Moreover, as a result of the diverse nature of the individual teachings of these references, there is clearly no suggestion in the prior art itself to combine these references in any manner rendering Claim 21 obvious. See, for example, In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997); and Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983).

In conclusion, Applicant respectfully requests that:

1. The finality of the Official Action dated May 19, 2005 be reconsidered and withdrawn;
2. The prior art rejections of the claims be reconsidered and withdrawn; and
3. The amendment made herein to the form of dependent Claim 5 be entered, even if the finality of the outstanding Official Action is not withdrawn, on the grounds that the Amendment is directed exclusively to matters of form, does not affect the scope of the claim, and does not require any further search or consideration by the Patent & Trademark Office.

Applicant submits that the present application is in condition for allowance, and favorable action is respectfully requested.

Respectfully submitted,



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